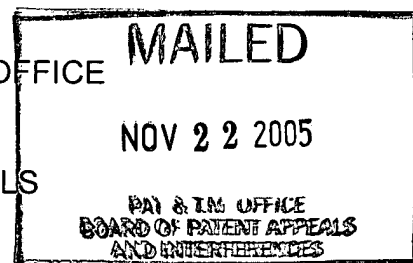


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JORG SCHABERNACK AND MONIKA BANZHAF

Appeal No. 2005-2583
Application No. 09/328,893

On Brief

Before BARRY, LEVY, and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 10 which constitute all the claims remaining in the application. For the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 10. However, we enter a new grounds of rejection against claim 1.

THE INVENTION

The invention relates to an apparatus for management of a network element using managed objects. In response to a request for access to one of the managed objects a check is made to determine whether the requested object is stored in memory. If the requested object is not in memory, and there is

insufficient memory space free to load the object, at least one object in memory is swapped out to make room for the newly requested object. See page 2 of appellants' specification.

Claim 1 is representative of the invention and is reproduced below:

1. A method (100) comprising the steps of:

checking in response to a request (RQ=RQ*) for access to one (MO*) of a plurality of managed objects (MO1, MO2, MO*) whether this requested object (MO*) is stored in a memory (MEM) (step 110) of a network element connected to a Synchronous Digital Hierarchy (SDH) network;

if this requested object (MO*) is not stored in the memory (MEM),
checking whether there is sufficient memory space to write this object (MO*) into memory (MEM)(step 120);

if there is no sufficient memory space, swapping at least one (MO1) of the stored objects (MO1, MO2) out of memory (MEM) to a database (DB) according to at least one predeterminable criterion (step 130); and

reading the requested object (MO*) from the database (DB) and writing it into the memory (MEM) (step 140).

THE REFERENCES

The reference relied upon by the examiner are:

Mishra	6,339,587	January 15, 2002 (effective filing date March 5, 1998)
Finni	5,941,978	August 24, 1999 (effective filing date June 30, 1997)
Bennett et al. (Bennett)	5,189,733	February 23, 1993

The reference we rely upon in our new grounds of rejection is:

M.P Bosse et al. (Bosse), Management of SDH Network Elements: An Application of Information Modeling, *Electrical Communication*, 4th Quarter 1993, pages 329-338. (Of record and discussed in appellants' specification on page 2).

THE REJECTION AT ISSUE

Claims 1 through 3 and 5 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Bennett in view of Mishra. Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Bennett in view of Mishra in view of Finni. Throughout the opinion we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellants and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 103.

Appellants assert on pages 7 and 8 of the brief that Bennett teaches a memory management system in a computer system in which, if a desired object is not resident in memory, another object will be swapped out of memory to make space for the desired object which is then swapped into memory from a

storage device. On page 8 of the brief, appellants argue that Bennett does not teach “managed objects” as claimed, rather Bennett teaches “code objects.” On pages 9 through 12 of the brief, appellants present arguments relying on citations from the appellants’ specification and from prior art documents to show that a skilled artisan in the area of managing network elements, would not consider Bennett’s “objects” to be “managed objects.”

The examiner responds on pages 7 and 8 of the brief, stating:

Examiner has given the broadest reasonable interpretation of the managed object (read as object) in view of the specification of the invention (see page 2, lines 20-30) since the managed object has not been specifically defined in the claimed invention.

We disagree with the examiner’s rationale. Claim 1 includes the limitation of “checking in response to a request for access to one of a plurality of managed objects whether this requested object is stored in a memory of a network element” (item numbers omitted). Independent claims 7 and 9 contain similar limitations. In analyzing the scope of the claim, office personnel must rely on appellants’ disclosure to properly determine the meaning of the terms used in the claims. ***Markman v. Westview Instruments, Inc.***, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) ***In re Cruciferous Sprout Litigation***, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing ***Intervet America Inc v. Kee-Vet Laboratories Inc.***, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). Initially we note that much

of the evidence appellants' arguments rely upon to help define the claim limitation "managed objects" is extrinsic to the appellants' specification. Our reviewing court has stated that they view "extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms, for several reasons. First, extrinsic evidence is by definition not part of the patent and does not have the specification's virtue of being created at the time of patent prosecution for the purpose of explaining the patent's scope and meaning." *Phillips v. AWH Corp.*, 415 F3d 1303, 1308 75 USPQ2d 1321, 1330 (Fed. Cir. 2005). Thus, we focus on the evidence in appellants' specification. The examiner points to page 2, lines 20-30 to teach that managed objects are objects. We concur with the examiner and find that page 2 lines 20-30 of appellants' specification identifies that managed objects are objects, which are stored in memory. However, we consider that managed objects are a subset of objects, appellants' specification on page 1 (discussing M.P. Bosse's article Management of SDH Network Elements: An application of Information Modeling)¹, identifies that in the context of managed networks, managed objects are objects which contain all relevant data to manage a network element. Thus, we consider the scope of claim 1 to include checking in a memory of a network element to see if an object which contains all of the relevant data to manage a network object is in memory.

We do not find that Bennett teaches that the objects being swapped in and out of memory are managed objects within the meaning of claim 1. Contrary

¹ Appellants specification identifies the article in German vice English.

to appellants' arguments, we find that Bennett teaches that the objects are code or data. See column 1, lines 46. However, we do not find that Bennett teaches that the objects contain all of the relevant data to manage a network element, rather Bennett teaches that the object are associated with software running on a general purpose computer. See column 1, lines 10-30. Further, we find that Mishra teaches synchronous digital hierarchy network used for communication between computers, however we do not find that Mishra teaches that the network elements are controlled by managed objects stored in computer memory. Accordingly, we will not sustain the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 103 as being unpatentable over Bennett in view of Mishra.

New grounds of rejection in accordance with 37 CFR § 41.50(b)

We find that independent claim 1 is unpatentable over Bosse and Bennett and enter a new ground of rejection under 35 U.S.C. § 103. In entering this new ground of rejection we considered only independent claim 1 and we leave it to the examiner and appellants to determine if the other claims in the application are similarly obvious in light of our finding. We find that Bosse teaches a Synchronous Digital Hierarchy (SDH) network which includes several network elements. See Bosse, first column of text on page 329. The network elements in this SDH network are managed using "managed objects." Bosse teaches that "managed objects" are similar to "typical objects," however "managed objects" are more specialized. See Bosse, third column on page 331. On pages 330 and

331, Bosse briefly discusses the controller which implements the “managed objects,” however Bosse is silent as to the controller’s hardware configuration and how the controller handles the objects. As stated, *supra*, we find that Bennett teaches a memory management system which operates such that when there is a request for an object, a check is performed to determine if the object is resident in memory. If the object is not resident in memory, the main memory is checked to see if there is enough space for the requested object. If additional memory space is required, the amount of available memory is increased by swapping out other objects until sufficient memory is available, then the requested object is loaded. See Bennett column 7, lines 3-24. While Bennett’s primary disclosure is directed to an embodiment using personal computers, we consider Bennett’s teaching to be broader and apply to memory management in devices which operate using objects. Thus, it is our opinion that one of ordinary skill in the art would be motivated to use Bennett’s memory management system for devices implementing object oriented programming, in the object oriented SDH network controller taught by Bosse, for the purpose of making the greatest use of the memory in the controller. As stated, *supra*, we find that managed objects are similar to typical objects. Bosse identifies that Managed objects are more specialized “because they reflect the asymmetry of the manager/agent relationship.” We consider that one of ordinary skill in the art would not be deterred from combining the teachings of Bennett and Bosse based upon these differences and would recognize that differences would not impact how the devices, on which the objects run, manage the memory allocated to the objects.

Conclusion

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief or by filing a reply brief have not been considered and are deemed waived by appellants (see 37 CFR § 41.37(c)(vii)). Support for this rule has been demonstrated by our reviewing court in *In re Berger* 279 F3d 975, 984, 61 USPQ2d 1523, 1528-29 (Fed. Cir. 2002), wherein the Federal Circuit stated that because the appellants did not contest the merits of the rejections in his brief to the Federal Circuit, the issue is waived. *See also In re Watts* 354 F.3d 1362, 1368, 69 USPQ2d 1453, 1458 (Fed. Cir. 2004).

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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